

REMARKS

Claims 1 and 8 have been amended by incorporated the subject matter of claims 2 and 9, respectively. Claims 2 and 9 have been canceled.

Claims 10-12 have been amended to indicate the optional inclusion of the additional components.

New Claim 14 has been added, specifying that the polymeric wetting agent is (b2) a polymer containing a hydrophilic backbone modified with hydrophobic groups.

The Present Invention

The present invention relates to a cosmetic composition for skin and hair which delivers a moisturizing effect, without a sticky sensation. The cosmetic non-sticky moisturizer for skin and hair includes

- (a) at least about 10% by weight of the composition of a polyhydric alcohol humectant;
- (b) about 0.01% to about 10% of a polymeric wetting agent which forms a uniform film in a Wetting Test;
- (c) an elastomer;
- (d) a cosmetically acceptable vehicle.

The moisturizing capabilities of humectants, such as glycerol and sorbitol which may be generally known, are concentration dependent. Unfortunately, when incorporated into formulations at concentrations above 10%, they confer a sticky, tacky feeling. Due to this unpleasant consumer sensory experience, formulations containing higher levels of humectants are, for the most part, not commercially acceptable. The present invention meets the need for commercially acceptable moisturizing compositions containing higher levels of humectants. *Specifically, the polymeric wetting agents are selected for inclusion in the inventive compositions by testing the polymer in a Wetting Test.* The polymeric wetting agent may be an amphipathic block copolymer, a polymer containing a hydrophilic backbone modified with hydrophobic groups, or mixtures thereof.

35 USC § 112 Rejection Has Been Obviated

Claims 10 - 12 have been amended to indicate optional inclusion of the components recited therein, with the intention of obviating the rejection under § 112. Claim 9 has been canceled.

35 USC § 102 Rejection Has Been Rendered Moot By Claim Amendment

The rejection of claims 1, 3, 5 and 7 under 35 USC 102(b) as being anticipated by Brewster et al. (US 5,128,123) has been rendered moot, by the amendment of claim 1 to incorporate the subject matter of claim 2. This amendment has been made in the interest of expediting the prosecution of this case to issuance and/or to simplify issues for appeal. The amendment is not believed to be necessary for patentability for, *inter alia*, the reasons below.

According to the Office Action, the *clear cosmetic stick* of Brewster reads on the scope of the claims, and a composition that reads on the composition of generic claim 1 would inherently be non-sticky. Applicants respectfully traverse the rejection. The "stick" of Brewster et al. does not necessarily read on the scope of the claims. In fact, the teachings of Brewster et al. teach away from the present invention, as the "stick" of Brewster et al. must necessarily be sticky in order to be in the form of a stick. This art falls in the category distinguished by the present invention, i.e., the present invention as claimed in claim 1 eliminating the stickiness by incorporation of polymeric wetting agents that meet the specified Wetting Test.

To establish that a particular element is **inherently** disclosed by a reference, the Office Action must establish that the descriptive matter missing from the reference is *necessarily* present within the reference's disclosure, and that persons of ordinary skill in the art would *recognize* the presence of that element. Continental Can Company, U.S.A. v. Monsanto Company, 20 U.S.P.Q.2d 1746 (Fed. Cir. 1991). *Contrary to the Office Action comments, the*

rule of this case is not limited to the facts of the case, rather stating the requirements for inherency/ anticipation. In this instance, the Wetting Test element of Claim 1 is at issue.

There can be no *inherency* because the **Wetting Test element is not shown to always be present/met, in Brewster et al.**, nor can it be recognized by one skilled in the art from the disclosure therein. There is no *inherency* here because Brewster et al do not disclose expressly or by necessity a polymeric wetting agent that forms a uniform film in a Wetting Test. There can be no inherency unless it can be shown that the disclosure of Brewster et al. will always and *necessarily* employ a polymeric wetting agent that forms a film in a Wetting Test and will *necessarily* employ the claimed combination of ingredients. *On the contrary, Brewster et al. suggest a sticky composition, thereby teaching away from the present invention. Applicants have shown that their composition would be non-sticky with experimental data regarding the role of the Wetting Test, which is the missing element at issue for purposes of anticipation.* The data in Tables A and B at page 5 of the present specification show that not all polymers form a uniform film in a Wetting Test. For example, while Pemulen TR2 forms a uniform film, Carbopol 981 does not. Example 1 on pages 11-12 of the specification also demonstrate the non-inherency of the uniform film characteristic, in Table 1 and comparative Table 2.

In sum, inherency may not be established by probabilities or possibilities. Continental Can Company, U.S.A. v. Monsanto Company, 20 U.S.P.Q.2d 1746 (Fed. Cir. 1991). The PTO has not shown that the claimed product and those of the prior art are the same. Since Brewster et al. Fails to disclose **either explicitly or inherently** a polymeric wetting agent which forms a uniform film in a Wetting Test, a person skilled in the art would not find that Brewster et al inherently disclose a non-sticky composition.

Nevertheless, in the interest of progressing the present case to issuance without delay, Applicants have amended the independent claim 1 so as the render moot the rejection.

There is No Obviousness under 35 USC § 103

Brewster et al.

Claim 4 (volatile silicone oil) and claim 6 (oil) were rejected under 35 USC 103(a) as being unpatentable over Brewster et al. (US 5,128,123). Applicants respectfully traverse this rejection. Applicants respectfully submit that, as claim 1 is novel and unobvious over Brewster et al., its dependent claims 4 and 6 are likewise novel and not obvious. Additionally, the disclosure of Brewster et al. appears to be suitable to deodorant type products and is not specifically aimed at a non-sticky cosmetic moisturizer for skin and hair.

Beerse et al.

Claims 1-7 were rejected under 35 USC 103(a) as being unpatentable over Beerse et al. (US 6,294,186). According to the Office Action, the Beerse composition comprises hydrophilic gelling agents amongst which is listed PEMULEN TR-1 and oleogels; the composition may also contain from about 0.1% to about 20% lipophilic skin moisturizing agents/emollients such as polymethyl siloxanes, methylphenylpolysiloxanes, dimethicones, cyclomethicones, alkyl siloxanes and oils (col. 10, line 7 to col. 11, line 16); Dimethicone copolyol emulsifiers are useful in Beerse (col. 15, line 36 to col. 16, line 59). Beerse's composition may also contain conditioning agents selected from humectants, moisturizers or skin conditioners in an amount from about 0.1% to about 20%, and examples of moisturizing agents are polyhydroxy alcohols such as sorbitol, glycerol, hexanetriol, propylene glycol (col. 36, lines 14-35). Beerse et al provide an example of thickening agents that can be contained in the composition and specific examples of PEMULEN TR-2 and PEMULEN TR-1 are listed (col. 36, line 54 to col. 38, line 23). Beerse's composition *optionally* contains detackifying agents that reduce stickiness or tack associated with humectants and/or gelling agents (col. 38, lines 33-43). Beerse also discloses that silicone elastomers are also useful as detackifying agents and cyclomethicone and

dimethicone crosspolymer blend is listed as example of the silicone elastomer (col. 40, lines 33-63).

The Office Action cites Examples 16-18 as teaching hand compositions that contain 20% glycerin, 8% dipropylene glycol, 22.8-28.09% water, 4% isopropyl palmitate, 9.1-13% cyclomethicone, 11-14.55% cyclomethicone/dimethicone copolyol, salicylic acid, fragrance, etc.

Therefore, according to the Office Action, it would have been obvious to one of ordinary skill in the art at the time the invention was made to increase the amount of polyhydric alcohol in the hand composition in examples 14 and 15 of Beerse from 3.08 to about 20-28%, since Beerse in examples 16-18 teaches hand composition that contains 20-28% polyhydric alcohol.

Applicants respectfully traverse. Claim 2 has been deleted and its subject matter incorporated in claim 1. *Beerse et al. related to antimicrobial compositions comprising benzoic acid. Beerse et al. do not disclose or suggest a selection of Pemulen TR2 over Pemulen TR1.* Beerse et al may disclose Pemulen TR1 and Pemulen TR2, however, the data in the present Specification show that Pemulen TR-2 but not Pemulen TR-1 meets the Wetting Test. Carbopol 981 disclosed in Beerse et al likewise does not meet the Wetting test. Examples 14 and 15, cited as containing PEMULEN TR-1 and CARBOPOL in addition to glycerin, butylene glycol, cyclomethicone and dimethicone copolyol, cyclomethicone and dimethicone, dimethicone copolyol, salicylic acid and water, teach away from the present invention. As discussed, the data in the present Specification indicate that CARBOPOL and Pemulen TR-1 are outside the scope of the present invention, since it does not meet the Wetting Test. The unique combination of components in the claimed amounts according to the present invention yields an unexpectedly moisturizing but non-sticky composition.

An obviousness rejection is proper only when "the subject matter as a whole would have been obvious at the time the invention was made ..." (emphasis added). 35 U.S.C. 103.

Applicants respectfully submit that the Office Action has improperly picked and chosen certain aspects of the reference, without showing where the motivation is to combine them to come up with the subject matter of the present invention as a whole, within the meaning of 35 U.S.C. 103.

The Court of Appeal for the Federal Circuit has repeatedly held that when making out a *prima facie* case of obviousness, the focus must be on the invention as a whole,

That features, even distinguishing features are "disclosed" in the prior art is alone insufficient. As above indicated, it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. 35 U.S.C. 103.

Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1549, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

Applicants have shown that the teachings of the cited reference in its entirety would not lead one of ordinary skill in the art to combine the teachings to produce the claimed invention. The cited reference concerns other aspects that are not related to the composition elements as claimed.

Spellman

The Spellman reference has been cited in the Office Action in support of alleged obviousness of claims 8 and 13. Claim 8 has been amended to incorporate the subject matter of claim 9. Applicants respectfully traverse this rejection.

Spellman describes the presence of Carbopol, while Applicants have shown that Carbopol 981 does not meet the Wetting test. Spellman fails to disclose or suggest polymeric wetting agents that meet the Wetting Test, i.e., that form a uniform film in a Wetting Test.

Applicants respectfully assert that claims 1, 3, 5 and 7 are not anticipated by Brewster et al. Applicants submit that the pending claims 1, 3-8, 10-14 are not obvious over the cited references, under 35 U.S.C. 103. Reconsideration and withdrawal of the rejection is respectfully requested.

Respectfully submitted,



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